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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/779,559	02/09/2001	Richard Levy	01064.0011-06000	9094

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The Law Offices of Robert J. Eichelburg
Hodafel Building
Suite 200
196b Acton Road
Annapolis, MD 21403

EXAMINER
GRAY, JILL M

ART UNIT	PAPER NUMBER
1774	12

DATE MAILED: 04/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application N .	Applicant(s)	
	09/779,559	LEVY, RICHARD	
	Examiner	Art Unit	
	Jill M Gray	1774	

-- The MAILING DATE of this communication appears on the cover she t with th correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 August 2002* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *57-77* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *57-61,63-71 and 73-77* is/are rejected.

7)☒ Claim(s) *62 and 72* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *4* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: the current status (whether patented, pending or abandoned) of each parent application must be indicated.

Appropriate correction is required.

Response to Amendment

The objection to the abstract is moot in view of applicant's submission of a new abstract.

The rejection of claims 57-77 under 35 U.S.C. 112 first paragraph for the language of "essentially water-free" is withdrawn in view of applicants arguments and further consideration of the disclosure of the invention.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> **The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.**

3. Claims 63 and 73 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. More specifically, there is no support in the specification for a coated cable. The specification only teaches that certain lubricants that can be used find use in transformers, cables and

refrigerator compressors. The fact that certain lubricants find use in cables does not provide support nor basis for the invention as claimed in claims 63 and 73, particularly when there is no teaching or disclosure, either express, inferred or implicit of the invention of claims 63 and 73 comprising a cable coated with an essentially water-free composition, wherein said composition comprises a superabsorbent polymer in combination with the requisite compound and method of making same.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> **The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.**

5. Claims 61 and 71 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In particular, these claims do not further limit the compound of claims 57 and 67. The language of "and said compound is" in dependent claims 61 and 71 adds components that the compound can be selected from in addition to those of claims 57 and 67. This does not narrow the scope of claims 57 and 67, but results in dependent claims that broaden the scope of the base claims. This is impermissible and renders the metes and bounds for which patent protection is being sought unclear.

If applicants' intent is to further define the petroleum lubricant, the suggested language in claims 61 and 71 is "and said petroleum lubricant is a petroleum oil". Similarly, if applicants' intent is to further define the synthetic lubricant, the suggested language in claims 61 and 71 is "and said synthetic lubricant is a silicone, an organic ester, or a glycol and combinations thereof."

Claim R j ctions - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 57-61, 63-71, 73-77 are rejected under 35 U.S.C. 102(b) as being anticipated by PCT Publication No. WO 93/18223 (Geursen), essentially for reasons of record.

Geursen teaches a process for treating a substrate with a composition comprising a composition that comprises a superabsorbent polymer in an oil-and-water emulsion, wherein the liquid constituents of the emulsion are wholly or partially removed from the substrate. See abstract. In addition, the composition comprises a lubricant and additive of the sort contemplated by applicants in claims 57-58, 61, 65-68, 71, and 75-76. See pages 7 and 8. The substrate can be wire or cable as set forth in claims 63-64 and 73-74. See page 14. As to claims 59-60, 69-70 and 77 and the requirement that the superabsorbent polymer absorbs greater than 100 times its weight in water, Geursen teaches the same type of superabsorbent polymer contemplated by applicants, accordingly, this property is inherent. See page 6. Furthermore, Geursen teaches on page 3, that superabsorbent polymers known in the art capable of absorbing 10 to 100 times its own weight in water are copolymers of acrylic acid salt, acrylic acid, and acrylonitrile. Again, as set forth previously, this property is inherent.

Therefore, the teachings of Geursen anticipate the invention as claimed in claims 57-61, 63-71, and 73-77.

Response to Arguments

8. Applicant's arguments filed August 22, 2002 have been fully considered but they are not persuasive.

In reference to the rejection of claims 63 and 73 under 35 U.S.C. 112, first paragraph, applicants argue that pages 6-19 of the written description describe the various lubricants used in combination with the superabsorbent polymers and page 20 of the written description states that applicants' lubricant composition comprises a superabsorbent polymer in combination with lubricants described in the written description which include those of pages 6-19, wherein one of the lubricants described includes cable lubricants, which supports claims directed to the lubricant of the invention on a substrate comprising a cable.

In response thereto, applicants' attention is directed to paragraph 3 of the present Office Action, which addresses this argument.

Applicants argue that the teachings of Geursen discloses an aqueous polymerization which appears to prevent Geursen from obtaining a polymer that absorbs greater than about 100 times its weight in water, further arguing that since Geursen contains experimental data showing the production of superabsorbent polymers that absorb only about 45 times their weight in water, he lacks an enabling disclosure of how to produce oil in water emulsions of superabsorbent polymers that absorb greater than about 100 times their weight in water.

It is the examiner's position that, even if Geursen does not itself specifically teach one of ordinary skill in the art how to make the coated article, he nonetheless teaches each claimed element of the article thereby anticipating the claims. In addition, applicants' method claims are not limited to any specific method steps resulting in superabsorbent polymers that absorb greater than about 100 times their weight in water. Moreover, Geursen teaches swelling values of 100-700 and higher. Surely this teaching embraces an absorbency of about 100 times its weight in water. Also, Geursen teaches using superabsorbent polymers known to have an absorbency of 10-100 times their weight in water. Thus it is not clear as to whether applicants are referring to the superabsorbent polymer per se that have this property or an end product, e.g. the coated substrate.

Applicants argue that the experimental data of Geursen clearly suggests that the inventors did not know how to combine a lubricant with a superabsorbent polymer that absorbs greater than about 100 times its weight in water, further arguing that Geursen only teaches superabsorbent polymer that absorbs about 45 times its weight in water and the recitation in the Geursen written description of superabsorbent polymers that absorb more does not overcome the lack of enablement of Geursen of how to combine these polymer with a lubricant.

In this regard, the teachings of Geursen are relied upon for all that they would have reasonably imparted to one of ordinary skill in the art at the time the invention was made, namely, the formation of a coated substrate comprising a superabsorbent polymer and a lubricant, wherein the superabsorbent polymer is selected from those

known in the art, including those having absorbency of greater than 100 times their weight in water. In addition, the teachings in a prior art reference must be considered for all that they reasonably teach and disclose and are not limited solely to that which is set forth in the examples or preferred embodiments. Arguments with respect to the lack of enablement have previously been addressed.

Applicants argue that even though Geursen discloses superabsorbent polymers having water absorbencies greater than 100, the reference does not teach how to apply them to a substrate.

In this concern, applicants' method claims are not limited to any specific process steps, which does not distinguish the prior art method from that claimed by applicants. As to the claims drawn to the product, arguments with respect to the process of making are not germane because patentability of a product relies solely upon the product itself.

Allowable Subject Matter

9. Claims 62 and 72 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill M Gray whose telephone number is 703.308.2381. The examiner can normally be reached on 10:00-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 703.308.0449. The fax phone numbers for the organization where this application or proceeding is assigned are 703.305.5408 for regular communications and 703.305.3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.308.0651.

Jill M Gray
Examiner
Art Unit 1774

jmg
April 7, 2003

CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700